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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Atty. Docket: EDELMAN-1

In re Application of:	)	Conf. No.: 1629
	)	
Meir EDELMAN	)	Art Unit: 1638
	)	
Appln. No.: 09/529,172	)	Examiner: Ashwin D. Mehta
	)	
Filed: September 11, 2000	)	Washington, D.C.
	)	
For: TRANSGENIC LEMNACEAE	)	June 4, 2004
	)	
	)	

CORRECTED REQUEST FOR INTERFERENCE UNDER 37 CFR §1.607

Honorable Commissioner for Patents  
U.S. Patent and Trademark Office  
2011 South Clark Place  
Crystal Plaza Two, Lobby, Room 1B03  
Arlington, VA 22202

Sir:

Pursuant to 37 CFR §1.607, applicants hereby request to have an interference declared between the above-identified application and U.S. patent 6,040,498. The requirements of 37 CFR §1.607(a) will be fulfilled in the following sections which correspond to the sub-sections of 37 CFR §1.607(a).

(1) The patent is identified as Stomp et al patent no. 6,040,498, which patent is assigned on its face to North Carolina State University.

(2) The proposed count is:

Claims 1, 20 or 30 of U.S. patent 6,040,498

or

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Claims 65, 66 or 67 of application 09/529,172.

(3) All of claims 1-65 of patent 6,040,498 correspond to the proposed count.

(4) At least claims 1, 12, 55 and 65-67 of the above-identified application correspond to the proposed count.

Application claims 65-67 correspond exactly to the second paragraph of the bifurcated proposed count.

Application claim 1 corresponds to the proposed count as it is a broader claim that encompasses the subject matter of application claim 66, which corresponds exactly to the count. They are drawn to the same patentable invention, as each would be obvious over the other if the other were available to the prior art (37 CFR 1.601(n)). The product-by-process limitation of an *Agrobacterium* mediated method in application claim 66 does not affect the scope of the claim and integration into the chromosome is required for genetic stability, so the scope of application claims 1 and 66 are substantially the same.

Application claim 12 corresponds to the count as it too is broader than and fully encompasses application claim 65, which corresponds exactly to the count. The recitation of *Lemnaceae* plants in application claim 65 is not patentably distinct from the recitation of *Lemnaceae* whole plants, plant tissue or callus in application claim 12. None of the other differences are

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substantial. Thus application claim 12 is directed to the same invention as application claim 65.

Application claim 55 has slightly different wording but is substantially the same as the wording of application claim 67, which corresponds exactly to the count. Thus, claim 55 also corresponds to the count.

Patent claims 2-17, 42-57, 64 and 65 correspond to the count as none are patentably distinct from patent claim 1, which corresponds exactly to the count. Once the basic method of patent claim 1 is known, then the added features of the dependent claims or of independent patent claim 48 and those claims dependent therefrom would all have been obvious therefrom.

Patent claims 18, 19, 21-29, 40, 41 and 58-61 all correspond to patent claim 20, which itself corresponds exactly to the count. Each of said claims are drawn to stably transformed duckweed plant or tissue, adding additional limitations, each of which would have been obvious if patent claim 20 were assumed to be prior art. Thus, each correspond to the count.

Claims 31-39, 48-57 and 65 are all patentably indistinct from patent claim 30, which corresponds exactly to the count. Accordingly, each of said claims also correspond to the count.

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(5) Application claims 1, 12 and 55 identified as corresponding to the count have previously been in the application, and, thus, the terms of same need not be applied to the disclosure of the application pursuant to 37 CFR §1.607(a) (5). Claims 65-67 have been presented on even date herewith. The following table applies the terms of these claims to the disclosure of the application.

<u>Terms of the Claim</u>	<u>Terms of the Disclosure</u>
65. A method for the stable genetic transformation	Page 3, lines 25-26
of <i>Lemnaceae</i>	Page 4, lines 2-3
plant tissue, comprising:	Page 4, lines 6-7
inoculating <i>Lemnaceae</i> tissue with <i>Agrobacterium</i>	Page 30, lines 6-3 from the bottom
containing a transforming DNA molecule	Page 3, lines 27-30
having a heterologous DNA of interest; and	Page 3, line 17
co-cultivating the tissue with the <i>Agrobacterium</i>	Page 30, line 2 from the bottom, to page 31, line 2
to produce the stably transformed <i>Lemnaceae</i> tissue.	Page 12, lines 29-32
66. A genetically stable <i>Lemnaceae</i> plant	See claim 1 as originally filed and page 3, lines 25-
comprising a heterologous DNA of interest	Page 3, line 17
integrated into the chromosome,	Page 4, line 2 and page 34, lines 28-30

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Terms of the Claim

wherein said plant is produced via an *Agrobacterium*-mediated method.

67. A method of production of a product of interest, comprising:

culturing a stably transformed *Lemnaceae* plant

that expresses at least one heterologous product; and

isolating and purifying said at least one heterologous product.

Terms of the Disclosure

Page 5, lines 11-12

See claim 54 as originally filed

Page 4, lines 22-23

Page 3, line 17, page 4, lines 19-20 and page 5, lines 7-9

Page 4, lines 23-24

(6) The Stomp et al patent issued on March 21, 2000.

At least application claims 1, 12 and 55, which have been shown to correspond to the count hereinabove, were first presented prior to March 21, 2001, therefore satisfying 35 USC 135(b).

In accordance with 37 CFR §1.607(b), it is requested that examination of this application be conducted with special dispatch within the Patent and Trademark Office. Furthermore, in accordance with 37 CFR §1.607(d), it is requested that a notice that an applicant is seeking to provoke an interference with the patent be placed in the file of the patent and a copy of the notice sent to the patentee without identifying the present applicants.

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STATEMENT UNDER 37 CFR §1.608 (a)

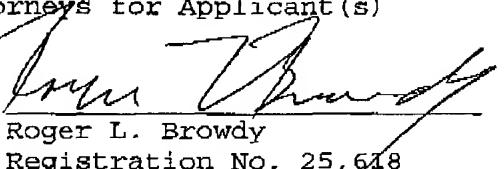
The present application is a §371 national stage application of PCT/IL98/00487 filed October 8, 1998, which is a continuation in part of PCT/IL97/00328, filed October 10, 1997. Claims 1, 12 and 55 of PCT/IL97/00328 are the same as claims 1, 12 and 55 of the present application as originally filed. Thus, the effective filing date of the present application is October 10, 1997.

The Stomp et al patent 6,040,498 claims an earliest effective filing date of August 12, 1997. Thus, the effective filing date of the present application is three months or fewer after the effective filing date of the patent. In order to comply with 37 CFR §1.608(a), the undersigned hereby states that there is a basis upon which the applicants are entitled to a judgment relative to the patentee.

Accordingly, it is requested that, following the determinations required therein, an interference be declared in accordance with 37 CFR §1.607(b).

Respectfully submitted,  
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## CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that these papers are being  
facsimile transmitted to the Patent and Trademark Office,  
Supplemental Amendment and attached Corrected Request for  
Interference Under 37 C.F.R. § 1.607, on the date shown  
below.

Jonathan Brammer

Name

  
Signature

June 4, 2004

Date